

REMARKS

Typographical errors have been corrected in the claims and in the specification. For example, spelling is corrected for the terms "heterocyclic" in Claims 1 and 14, and "triazolyl" and "thiazolyl" on page 10. Also, the terms " $-NR^aR^d$ ", " $-NHR^aR^b$ " and " $-SO_2NR^aR^b$ " on page 11 are amended to " $-N(R^aR^b)$ ", " $-N(R^aR^b)$ " and " $-SO_2N(R^aR^b)$ "; and similar corrections in Claims 4 and 17; and the like. No new matter is added by these amendments. Further, the scope of the claimed invention is not changed by these amendments.

The Rejection of Claims 1-26 under 35 U.S.C. § 101 is Improper

The Examiner provisionally rejected Claims 1-26 under 35 U.S.C. § 101 as claiming the same invention as that of Claims 1-56 of Application No 10/244,088 (now U.S. Patent No. 6,861,436, issued March 1, 2005, hereafter the "436 Patent").

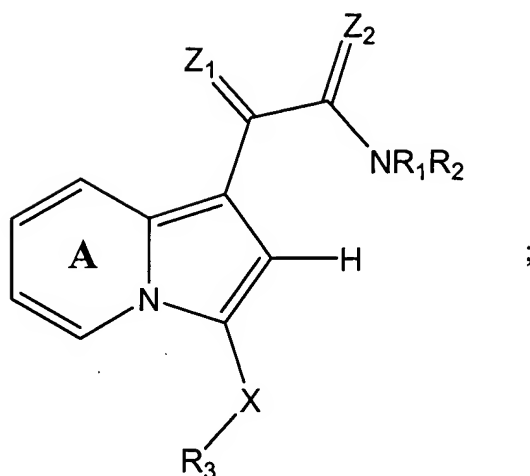
The rejection of Claims 1-26 under 35 U.S.C. § 101 is improper, however, because *the same invention is not claimed* by any two claims between the instant application and the '436 Patent. The MPEP § 804 II.A states:

A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). *Is there an embodiment of the invention that falls within the scope of one claim, but not the other?* If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. *[emphasis added]*

Further:

For example, the invention defined by a claim reciting a compound having a "halogen" substituent is not identical to or substantively the same as a claim reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine."

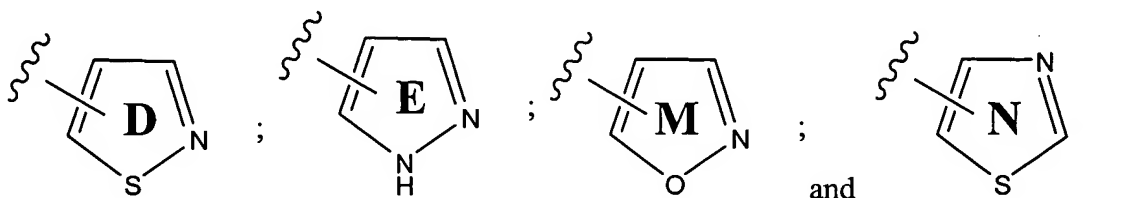
In the instant situation, statutory double patenting does not exist because no two claims between the instant application and the '436 Patent have the same values for all substituents. The respective claim sets are drawn to compounds represented in part by the following structural formula:



Statutory double patenting does not exist between the instant Claims and Claims 1-56 of the '436 Patent because no two claims have the same values for variables R_1 , R_2 , and R_3 .

For example, in instant independent Claims 1 and 14, R_1 and R_2 are independently -H, an aliphatic group, a substituted aliphatic group, an unsubstituted non-aromatic heterocyclic group, a substituted non-aromatic heterocyclic group, an unsubstituted aryl group or a substituted aryl group, provided that R_1 and R_2 are not both -H; or $-NR_1R_2$, taken together, is a substituted or unsubstituted non-aromatic nitrogen-containing heterocyclic group or a substituted or unsubstituted nitrogen-containing heteroaryl group.

By contrast, in independent Claims 1 and 20 of the '436 Patent, R_1 and R_2 are independently -H, an aliphatic group, a substituted aliphatic group, or a substituted or unsubstituted aryl group selected from:

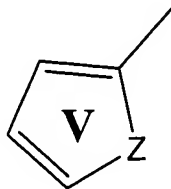


provided that R_1 and R_2 are not both -H.

Clearly, the scope of R_1 and R_2 is different in instant independent Claims 1 and 14 compared to independent Claims 1 and 20 of the '436 Patent.

Also, in instant independent Claims 1 and 14, R_3 is a substituted or unsubstituted aryl group or a substituted or unsubstituted aliphatic group. By contrast, in independent Claims 1 and

20 of the '436 Patent, R_3 is a substituted or unsubstituted aliphatic group or a substituted or unsubstituted aryl group represented by Ring V:



wherein Z is -O-, -S-, -NR-, or -CH=CH- and R is -H or C1-C4 alkyl.

Further, no other claims between the instant application and the '436 Patent have the same scope for R_1 , R_2 and R_3 . Therefore, the instant Claims and Claims 1-56 of the '436 Patent are not drawn to the same invention and statutory double patenting does not exist. The rejection under 35 U.S.C. § 101 is improper and Applicants respectfully request that it be withdrawn.

Terminal Disclaimer Under 37 C.F.R. § 1.321

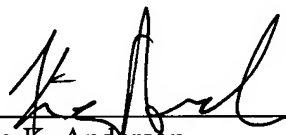
Applicants enclose a Terminal Disclaimer Under 37 C.F.R. § 1.321 with respect to the patent term of commonly owned U.S. Patent No. 6,861,436 to preclude any obviousness-type double patenting rejection thereover.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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